REAL PARTY IN INTEREST

The real party in interest is 3M Company (formerly known as Minnesota Mining and Manufacturing Company) of St. Paul, Minnesota and its affiliate 3M Innovative Properties Company of St. Paul, Minnesota.

RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 1, 4-10, 12-15, 18-33, and 35-72 are pending.

Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 stand rejected under 35 U.S.C. 102(e) as anticipated by Matsuo et al (US Patent No. 6,492,307). This is a new ground of rejection applied after the case was withdrawn from appeal.

Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 also stand rejected under 35 U.S.C. 103(a) as obvious over the combination of this same Matsuo et al (US Patent No. 6,492,307 in view of Hansen et al(US Patent No. 6,533,119). This also is a new ground of rejection applied after the case was withdrawn from appeal.

Claims 26-28, 31-33, 35-38, 45-53 and 55-72 stand rejected under 35 U.S.C. 103(a) as obvious over the combination of this same Matsuo et al (US Patent No. 6,492,307 in view of Kondo (PCT WO 99/29220). This also is a new ground of rejection applied after the case was withdrawn from appeal.

Claims 1, 4-9, 12-15, 18-33 and 55-72 stand rejected under 35 USC 103(a) over Kondo (PCT WO 99/29220) in combination with Sugiyama et al. (US 4,643,939). With respect to all the above claim, except claims 12, 26, 27 and 56, this combination is new, claims 1, 4-10, 13-15 18-25, 28-33, and 35-55, and 57-72 previously having been rejected based on Kondo alone.

STATUS OF AMENDMENTS

No amendments have been filed after the rejection following the withdrawal of appeal dated Feb. 22, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER

The claims at issue concern the issue of obviousness over applicant's previously filed patent application Kondo WO 99/29220 alone on in combination with Sugiyama et al. US 4,643,939.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The newly applied rejections based on Matsuo are inappropriate. as were the previous rejections based on Kondo.

Generally, the present invention is related as an improvement of the prior filed, commonly assigned, application to Kondo (PCT WO 99/29220). Kondo describes an oil absorbent cosmetic wipe that is formed of a microporous thermoplastic film. This has been a commercially very successful product in Japan where this category of products are commonly used to remove excess facial oil during the day. This takes the sheen off a person's face without the need to wash. Prior products used generally included rice paper and like paper products.

The microporous thermoplastic film cosmetic wipe of Kondo encompassed an entirely new approach to this market. This product gave the advantages of being very flexible films which had the ability to absorb relatively large amounts of oil very rapidly. These oil absorbent films also changed transparency upon absorbing oil providing feedback to the user that the films were working and which portions of the film were essentially filled with oil. These advantages made this product an instant commercial success in Japan.

The Kondo films were also different from the conventional pulp type cosmetic wipes in that they were hydrophobic rather than hydrophilic. This was an advantage in absorbing oil but made the films generally incapable of absorbing sweat. In order to provide the possibility to make the wipes capable of absorbing both oil and sweat Kondo suggested coating one face of the microporous film with a hydrophilic substance (page 9, line 8 to page 12, line 5). A long list of possible hydrophilic substances were taught by Kondo. Some of these hydrophilic substance taught by Kondo included hydrophobic film forming polymers (note page 10, lines 29-30). It is this specific teaching that forms the basis of the examiner's rejections based on Kondo, which as it applies to claim 1 has now been newly combined with Sugiyama

The present invention is directed at a different problem or opportunity when using the basic thermoplastic microporous film cosmetic wipe taught in Kondo.

When the microporous film wipe of Kondo is used to remove surface facial oil, the skin of the face is now more receptive to absorb or attach agents that may be desired on the skin. This is as the naturally repellent oil layer has been removed. The present invention is directed at how to deliver these active agents with the same wipe used to remove the oil while keeping the agent in a stable form prior to use. The solution proposed is incorporating the active agents into a flexible film forming coating that is placed on one face of the oil absorbing cosmetic wipe (note page 3, line 21) the film coating keeps the active agents immobilized but available for use. An issue is that as this coating must be sufficiently anchored to the porous cosmetic wipe such that it does not easily fall off or delaminate. To prevent delamination of the coating, applicants generally require that the coating penetrate into the porous microstructures of wipe but not so far that it fills all the pores such that the wipe can not serve in primary function of removing facial oil (note e.g. dependent claims 8 and 9). The wipe as such on one face has no coating and absorbs facial oil (as does the wipe of Kondo). Then the wipe is then turned over and the user uses the opposite face with the film forming coating having the active or skin modifying agent, which is intended not to remove anything but to deliver the active agent to the skin.

The invention wipes have one side that is uncoated to allow that side to absorb the facial oil then when the wipe is turned over, the coated face provided with a film forming polymer having an active agent, is used.

With respect to the previous prior art rejections based on Kondo the examiner had repeatedly referred to two isolated unrelated passages in Kondo. First to pages 6-7 (namely page 7, line 14 is alleged to teach "organic acid") of Kondo is referred to, which teaches additives used in melt processing the microporous film. Then, without basis in reason, asserts that these melt additives can be used with the hydrophilic substances used as film coatings taught in Kondo, and specifically with the polyvinyl alcohol listed on page 10. The hydrophilic substance coatings discussion is limited to pages 9-11 of the Detailed Description section of Kondo. The laundry list of hydrophilic coating materials mentions particulate materials, surface modifying chemicals and a couple of film forming polymers. However, nowhere does Kondo suggest that for the film forming polymers in his laundry list of possible film coatings that active agents could be incorporated into these film forming coating material.

The following arguments where previously submitted in the last appeal now withdrawn:

So lacking any teaching of active agents in the coating layer the examiner relied solely on the melt additives mentioned on pages 6-7. However these are melt additives solely used to form the porous film.

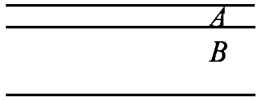
"Other additives may also be added as necessary in addition to the thermoplastic resin and filler in the main starting material for production of the porous stretched plastic film. For example organic acids ...." (page 7 line 11 on.)

"The main starting material and optional additives are melted and combined to form a film producing a filler-containing plastic film" (page 7, lines 17-18).

The additives are not in a coating layer and would not be able to deliver any benefit to skin or hair. They are melt additives in the thermoplastic film.

The additives to the film forming polymer coating of the claimed invention are additives that deliver a benefit to the skin or hair upon wiping. The specific melt additives taught in Kondo are for inclusion within the porous film per se, not to the coating and are taught not within the coating teachings at pages 9-11 of Kondo but rather pages 6-7. These are melt additives that are used to modify the characteristics of the porous film which is a polymeric material and these additives would provide no benefit to the skin or hair. These melt additives are intended to be locked within the polymeric structure of the thermoplastic extruded porous film. None of these melt additives are additives which are even capable of providing benefit to skin or hair. They are things like pigments to change the color of the thermoplastic film, or surface modifying agents which would affect the hydrophibicity or hydrophilicity of the film. There would be no reason to place any of these additives into the specific film forming polymers taught at pages 10 of Kondo and even if one were to do so, one still would not be providing an additive suitable or capable of delivering a benefit to skin or hair.

The melt additives taught on pages 6-7 of Kondo were discussed in relation to the extruded porous film taught in Kondo. This is different than what is claimed by the applicants. Applicants are not claiming melt additives for the porous film (the oil absorbing porous substrate). The claimed additives are for the film forming polymer coating. Kondo does not teach additives for a film forming polymer coating. In order to simplify this applicant referred to the basic diagram below with the examiner.



Applicant's claim a oil absorbing porous substrate (B) which has a film forming polymer coating (A). The claims recite that coating (A) has active or skin modifying additives. The Examiner relies on pages 6-7 of Kondo as generically teaching using additives. However, Kondo only teaches using these melt additives for the porous film (B) not the film forming polymer coating (A) and the melt additives are not ones capable of delivering a benefit to a person's skin.

In view of this the rejection based solely on Kondo was withdrawn and it was acknowledged in this new office action that Kondo does not teach an additive in a "coating solution". Sugiyama has been added to allegedly suggest adding a bactericide in one of the hydrophilic substances listed at page 9, line 8 to page 12, line 5 of Kondo, namely the one that could be characterized as a film forming polymer out of this very very long list of possible hydrophilic substances taught by Kondo.

The problem is that Sugiyama teaches a bactericide incorporated into their oil absorbing sheet formed of hemp or other plant fibers. The bactericide is intended to be used while the oil is removed from a users face. This would at best suggest possibly putting a bactericide into the oil absorbent microporous thermoplastic film of Kondo as this is the film that removes facial oil, but it is not seen how this teaching in Sugiyama would suggest modifying any of the long list of hydrophilic substances provided on one face of the Kondo oil absorbent microporous thermoplastic film to absorb sweat much less one particular one of these hydrophilic substances that also just happens to be potentially a film forming polymer.

In truth the examiners rejection is not understood as it appears to suggest modifying the Kondo oil absorbent sheet with the bactericide impregnated plant fibers of Sugiyama. This would be hardly be suggested by Sugiyama as his hemp fiber paper is the functional equivalent of Kondo's oil absorbent microporous thermoplastic. They are alternative solutions to an oil absorbent cosmetic wipe. Putting these quite different alternative oil absorbent sheet materials together would hardly be suggested by either reference and even if one of skill in the art were to make this combination, lacking any motivation or reason to do so, they would not be in possession with anything remotely resembling the oil absorbent wipe of applicants claim 1.

With respect to claims 4 and 5 neither Kondo or Sugiyama teach coating of a film forming polymer having a particulate filler.

With respect to claims 8 and 9 neither Kondo or Sugiyama teach coating the porous substrate such the film forming polymer coating penetrates a specific percentage of the porous substrate.

With respect to claim 10 there is no teaching of polyvinylpyrolidone in Kondo or Sugiyama.

With respect to claim 12 there is no teaching in Kondo or Sugiyama of using salicylic acid or any other specific additive in a film forming polymer layer.

NEW REJECTIONS BASE ON MATSUO

Matsuo et al. is directed at a personal cleansing sheets formed of two layers First there is an oily substance absorption layer 1 formed of a "woven or nonwoven fabric in the form of a sheet or film" (col. 3, line 4-6). Matsuo et al then briefly mentions, later in that same column, that the layer 1 could be a biaxially oriented film which has pores produced by "inorganic fine particles" (col. 3 line 25). The discussion then however reverts to discussing nonwoven fabrics exclusively (cols. 4-5). The second layer in Matsuo et al. is the "liquid retention layer 2". This layer is also a "nonwoven fabric" (note col. 5 line 59 – col. 6, line 8 et al.). There is absolutely no disclosure of this layer being "a film forming polymer". The lotions and polymers discussed on col. 6, line 34-36 are just contained with the second nonwoven layer 2.

The two layers are joined by hot melt adhesive (col. 8, line 25) with the cleansing liquid subsequently sprayed onto the nonwoven fabric second layer (col. 8, line 30).

This teaching in Matsuo et al. does not have any relationship to the invention of claim 1 where the porous oil absorbing layer is one that has a transparency of less than 65 percent and changes transparency upon absorption of oil which is coated with a film forming polymer having an active or skin modifying agent. Matsuo et al. is simply directed at two adhesively bonded fibrous webs (generally nonwoven fibrous webs), one nonwoven layer of which has lotions.

Matsuo et al. has no teaching of a film forming polymer coating. It is really totally unclear where this teaching is alleged to be found in Matsuo et al. However the rejection appears to point to col. 3 lines 4-10 for this teaching. This is just a teaching that the when layer 1 is a woven or nonwoven the fibers are formed of synthetic resins that are listed in this passage.

The basis for applying Matsuo et al as a reference alone or in combination with Kondo or Hansen et al is simply not understood.

Method Claims

The rejection of the examiner totally fails to indicate how the current method claims are taught in the references applied. The method claims require using a coating solution of a specific viscosity range and percent solids, which variables are indicated as critical to obtaining the physical structure claimed.

The claims require the film forming polymer form a coating on a given face of the porous substrate where the coating does not penetrate through the porous substrate to the opposite face of the porous substrate. This is important in that the porous substrate must remain porous on the opposite face in order to adequately function as an oil absorbing material as claimed, but also making sure that the coating is firmly anchored onto the porous substrate such that does not readily delaminate. This is a problem not addressed in the prior art nor does the prior art provide a solution to this problem. The Kondo reference clearly does not teach this limitation. Further the coating needing to be applied using in a specific viscosity range solution with a specific solidity, for this limitation to be present. This would not inherently flow from the teachings Kondo.

CONCLUSION

For the foregoing reasons, appellants respectfully submit that the Examiner has erred in rejecting this application. Please reverse the Examiner on all counts.

Respectfully submitted,

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Date

By: _____
William J. Bond, Reg. No.: 32,400
Telephone No.: 651-736-4790

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833